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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,461	07/09/2003	Juha Ollila	089229.00149	7954

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SQUIRE, SANDERS & DEMPSEY L.L.P.  
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TYSONS CORNER, VA 22182

EXAMINER
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LIPMAN, JACOB

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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07/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/615,461

Applicant(s)

OLLILA, JUHA

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-24 and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/15/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of claims 1-11, 14-24, and 28-31 in the reply filed on 1 June 2007 is acknowledged. The traversal is on the ground(s) that the different groups are different embodiments of the same invention. This is not found persuasive because although the subcombinations are usable together, they do not overlap in scope and each has separate utility, as outlined in the restriction.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

2. The examiner has considered the information disclosure statement (IDS) submitted on 15 March 2005.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 24 contain the trade name International Mobile Subscriber Identity. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claims scope is uncertain since the trademark or

trade name cannot be used properly to identify any particular material or product. A trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a standard for an identifier and possibly an intended use and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-3, 5-7, 9-11, 14-16, 18-20, 22-24, and 28-31, as best understood, are rejected under 35 U.S.C. 102(a) as being anticipated by XP-002286828, hereto referred to as XP.

With regard to claims 1, 11, 14, and 28-31, XP discloses a method for generating a subscriber identifier (page 452), including the steps of generating an identifier base string based on encrypting a subscriber identifying value (page 452 step 5) generating an integrity check value based on the identifier base string (page 452 step 6) and generating a subscriber identifier (page 452 step 7) based on a concatenation of the identifier base string and an integrity check value (page 452 step 6).

With regard to claims 2 and 15, XP discloses generating the identifier base string includes the steps of binary coding of the subscriber identifying value (page 452 step 1) concatenating a random number (page 452 step 2), and performing an encryption

algorithm on the concatenated binary coded subscriber identifying value and the random number (page 452 step 5), for generating the identifier base string.

With regard to claims 3 and 16, XP discloses in the subscriber identifier generating step, a base 64 conversion is performed on the concatenated identifier base string and the integrity check value (page 452 step 7).

With regard to claims 5 and 18, XP discloses appending an identifier type (time stamp).

With regard to claims 6 and 19, XP discloses providing a length for the identifier (page 452 step 4).

With regard to claims 7, 9, 10, 20, 22, and 23, XP discloses using a keyed (digest\_key) hash for the integrity check (page 453).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 8, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over XP.

With regard to claims 4, 8, 17, and 21, XP discloses encrypting the identifier with a passphrase (page 453), and the decryption function uses the same passphrase ("Now is the encryption time"). XP does not disclose how the decryption program knows which passphrase to use. The examiner takes official notice that it is well known in the art to

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include a key identifier with encrypted data. It would have been obvious for one of ordinary skill in the art to include this key identifier with the encrypted data of XP for the motivation of allowing use of multiple keys, thus increasing security.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 571-272-3837. The examiner can normally be reached on M-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

